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PATENT

REMARKS

Applicants respectfully request reconsideration of the application. Claims 1-10 and 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,606,609 to Houser et al. (Houser).

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,606,609 to Huntsman ("Huntsman").

The final rejection is improper because, even under the expanded guidelines of MPEP Section 706.07(a), the Examiner introduced a new ground of rejection that was neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Applicants did not amend the claims, but instead, only amended the priority claim. Also, Houser and Huntsman were not cited by the Applicants.

Applicants have canceled claims 1, 3-4 and 8 without prejudice. Applicants reserve the right to pursue these claims in a related application. Applicants have amended claims 2, 5, 7 and 9 to re-write them in independent form. No change in claim scope of the remaining, pending claims has occurred, and no new issues have been raised because claims 2, 5, 7 and 9 have merely been re-written in independent form. These changes to the claims are being made to focus the issues for appeal, and a notice of appeal is being filed concurrently with this response.

Applicants respectfully traverse the rejections of the claims. The pending claims include elements not disclosed, taught or suggested in the cited art. For example, regarding claim 2, Houser does not disclose how to decode an object identifier from a watermark embedded in a selected media object file, in combination with the other elements of the claim. Houser mentions a "watermark generator" that generates an "electronic watermark", but fails to describe decoding an object identifier from a watermark embedded in a selected media object file as claimed. Houser is completely silent as to any method for decoding an object identifier from a watermark created by the "watermark generator." Houser's watermark is designed to provide some form of visual indicia that is displayed or printed (e.g., "a difficult to forge image or icon", See Houser at col. 16, line 61), and Houser fails to describe any method for decoding an object identifier from this visual indicia.

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Similar arguments apply to claims 12, 15 and 20 regarding Houser's lack of watermark decoding.

Similarly, regarding claim 10, Houser fails to disclose decoding a watermark and displaying in an extension of the user interface metadata or an action associated with the media object file via the watermark. Houser refers to generating visual indicia called in "electronic watermark," but fails to describe decoding a watermark and associating metadata or an action with a media object file via the watermark.

Regarding claim 5, Houser fails to disclose the claimed metadata server or its interaction with other elements of the claim, such as a metadata server that returns metadata or an action as claimed. The Office has cited element 140 of Fig. 1, which merely corresponds to text at col. 8, lines 34-39 relating to storing or forwarding documents. The Office has also cited col. 15, lines 25-35, which is silent regarding forwarding an object identifier to a metadata server and displaying metadata or an action returned from the server.

Regarding claim 11, Houser and Huntsman fail to disclose or suggest inserting a handler into a document where the handler is operable to display metadata linked via the object identifier in response to user input as claimed in combination with the other claim elements. Though not entirely clear, it appears that the Office is taking the position that Houser's electronic watermark corresponds to the claimed "handler". However, Houser's electronic watermark is not "operable to display metadata linked via the object identifier in response to user input" as claimed. Huntsman does not disclose or teach this aspect of the claim either, and therefore, the cited art does not render claim 11 or its dependent claims obvious.

Regarding claim 7, Houser fails to disclose: "the metadata or action is displayed as a URL link to information or a program associated with the selected media object file" in combination with the other elements of the claim.

Regarding claim 14, Houser fails to disclose the claimed interaction with a metadata server, brand identifier, and representation of brand identifier.

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The pending claims include elements not disclosed, taught or suggested in the cited art as will be described in more detail in the forthcoming appeal brief.

While the final rejection is improper, Applicants have opted to appeal the rejection because the claims have been twice rejected.

Date: April 21, 2004

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Respectfully submitted,

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